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GERARD A MESSINA ESQ
KENYON & KENYON
ONE BROADWAY
NEW YORK NY 10004-1050

EXAMINER	
HARLE, J	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 37,798	Applicant(s) MERRIMAN ET AL.	
	Examiner Jennifer I. Harle	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10-12 + 16*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Applicant has amended claims 1, 7, 13, 16, 20, 23, 32 and 51-55. No claims have been cancelled. Claims 1-57 are rejected.

Interview Summary

1. In response to Applicant's comments to the Interview Summary, examiner respectfully submits that applicant was made aware that filings submitted after the telephone interview would not be considered until the next action on the merits as stated in the interview summary.

Extensions of Time

2. Due to Applicant's filing of the Notification Regarding the Settlement/Dismissal of Litigation, extensions of time will now be permitted.

Requirement for Information Under 37 C.F.R. 105

3. The examiner notes the Declarations filed by Dwight Merriman and Kevin O'Connor under 37 C.F.R. 1.132 and the additional filing of the Declaration of Dwight Merriman under 37 C.F.R. 1.131. The examiner would like to request the following additional information:

   1. Who are the "others" to whom Merriman is referring the business plan was shown prior to May 1996 and on what dates was it shown to them? (paragraph 4 Merriman 1.131 Declaration)

   2. On what date was the system tested on the live web site tested? (paragraph 6 (Merriman 1.131 Declaration)

   3. What was ISS's role in IAN or IAF prior to the summer of 1995?

4. What was the substance of Kevin O'Connor's conversation with Chris Buckingham and when exactly did it occur, what type of proposal was Chris Buckingham seeking, i.e. investment or services? (paragraph 24, O'Connor declaration)

Oath/Declaration

4. The examiner notes applicant's clarification of the error and traversal of the rejection of the declaration. However, the traversal on the grounds that the two words advertisement selection somehow explain identify an error and not a reiteration as discussed previously is not persuasive. As such, the rejection of claims 1-50 under the original declaration is maintained until applicant sets forth the error in the declaration and not in the amendment.

5. A Supplemental Declaration is required covering any claims amended after the original declaration specifying how the changes to the claims corrects the errors in the original patent.

Thus, claims 1-57 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 C.F.R. 1.175.

Double Patenting

6. Applicant has not traversed the double patenting rejection set forth in the previous office action. Applicant has not distinguished his claims over the co-pending applications. Claims 51-57 are very similar although broader versions of claims 2, 8, 17, 24, 33, 38 and 46, respectively. However, they are more similar in scope and language to those to which the double patenting rejection was

originally applied. Therefore claims 51-57 are incorporated into the double patenting rejection and the rejection is maintained.

Response to Amendment

7. The declaration filed on December 12, 1998 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kohda reference for the following reasons:

a) The declaration was not signed by all of the inventors of the subject matter claimed. (See paragraph 3 of the Declaration of Dwight Allen Merriman Under 37 C.F.R. 1.131) 37 C.F.R. 131(a) and M.P.E.P. 715.04 (a).

b) While applicant appears to set forth some facts to show that some parts of the invention were conceived and reduced to practice, these statements appear to be more of a general allegation that the invention was completed prior to the date of the reference. (Paragraphs 4 and 5 of the Merriman Declaration). Such a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. M.P.E.P. 715.07. The business plan relied upon fails to set forth, for example, all the characteristics relied upon for each node, nor does the business plan set forth the manner in which the links work as claimed or that the ad may not be displayed at the user node only that it be "displayable". Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184

USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

c) The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kohda reference to either a constructive reduction to practice or an actual reduction to practice. There is no discussion whatsoever of diligence by the inventors, merely an allegation that the invention was reduced to practice "a few months after the business plan was shown to others."

Thus, Applicant has failed to established a showing of facts such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. See 37 CFR 1.131 (b) Affidavit or declaration of prior invention to overcome cited patent or publication.

Therefore, Kohda, Wexler, and Angles are not removed as prior art as requested by Applicant at this point in prosecution and the rejections under those references are maintained. For applicant's convenience, the examiner has set forth the previously rejected claims as amended. It is noted that the amendments did not change the meaning of the claims nor their interpretation under either 102 or 103.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1, 3, 7, 9 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Kohda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser" (May 1996) (reference cited by Applicant).

As per claim 1, Kohda, et al. teaches a network supporting the hypertext transfer protocol comprising:

a user node having a browser program coupled to said network (Fig. 2), said user node providing request for information on said network (pg. 1495, col. 1, fourth paragraph);

a content provider node having a respective affiliate web site (Fig. 2 – Ordinary Web server and web page) responsive to requests for information from said user node to provide media content and advertising space for display of advertising content and a link message to said user node (Fig. 2);

an advertiser node having an advertiser web site including advertising content (Fig.2; pg. 1494, col. 2, first full paragraph); said advertiser node responsive to a request to provide said advertising content (pg. 1495, col. 1, Section 2.2); and an

advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon information stored about said user node at said advertisement server node, and identify said advertiser node as said selected advertiser node to said user node (Fig. 2 Advertiser's Web server and an advertisement web page; pg. 1495, cols. 1-2, Sections 2.2 and 2.3, and pp. 1497-98, Section 3.2); and

whereby said advertising content from said selected advertiser node is displayable at said user node (pg. 1495, col. 1, Section 2.2).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Kohda, et al. teaches a plurality of advertiser nodes (Fig. 2).

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

9. Claims 1, 5-7, 11, 13-14, 16, 20, 23, 27, 29-32, 39-40, 42-43, 45 and 49-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Wexler, U.S. Patent No. 5,960,409.

As per claim 1, Wexler teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 2, lines 43-46);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of advertising content (Col. 3, lines 36-44; Col. 4, lines 28-36);

an advertiser node having and advertiser web site including advertising content, said advertiser node responsive to a request to provide said advertising content (Col. 5, lines 1-23); and an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node and identify said advertiser node as said selected advertiser node as said selected advertiser node to said user node (col. 4, lines 37-67); and

whereby said advertising content from said selected advertiser node is displayable at said user node (Col. 4, lines 4-7).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Wexler teaches a plurality of advertiser nodes (Col. 5, lines 25-65).

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claim 16, Wexler teaches an advertisement server node selecting an advertising banner and the advertiser node being responsive to a request from the user node to identify a direct advertiser web site corresponding to the advertising banner (Col. 4, lines 54-67; Col. 5, lines 1-13; Col. 5, lines 36-43). Wexler also teaches that the advertiser node has a direct advertiser web site including direct advertising content

corresponding to said advertising banner, the advertiser node responsive to a request from the user node to provide the direct advertising content corresponding to the selection of the advertising banner by the user, the advertiser node providing a feedback signal to the advertisement server node representing user transactions at the advertiser node (Cols. 4-5, lines 54-13).

As per claim 20, Wexler discloses a network in accordance with claim 16,

wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (in the prior art, users can click through an ad banner to obtain additional information about the advertiser – disclosed in Description of the Prior Art; Wexler, cols. 4-5, lines 54-13); and further including

an advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by a user (in the prior art, each advertiser typically maintains a web site including advertising content about their products and services which corresponds to the ad banners displayed on content web sites – disclosed in Description of the Prior Art; Wexler, cols. 4-5, lines 54-13 and col. 5, lines 36-43),

whereby said advertising content from said advertiser node is displayed at said user node (once the advertiser's URL address is returned from the ad server to the user's browser, the user's browser would be redirected to the advertiser's web page,

and advertising content from that page would be displayed on the user's computer – Description of the Prior Art; Wexler, cols. 4-5, lines 54-13 and col. 5, lines 36-43).

As per claim 23, it is rejected for the same reasons set forth in claim 16.

As per claim 32 it is rejected for the same reasons set forth in claims 16 and 20.

10. Claims 1, 3-7, 9-16, 18-23, 25-32, 34-37, 39-40, 42-45, and 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles, et al., U.S. Patent No. 5,933,811.

As per claim 1, Angeles teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Abstract; col. 1, lines 45-55; cols. 5-6, lines 62-3; col. 8, lines 38-46; col. 10, lines 43-54);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 2, lines 54-58 and lines 63-66; Col. 3, lines 41-65; col. 7, lines 53-60; col. 12, lines 13-35);

an advertiser node responsive to a request to provide said advertising content, said advertiser node responsive to a request to provide said advertising content (Col. 4, lines 6-16); and an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server

node and identify said advertiser node as said selected advertiser node as said selected advertiser node to said user node (col. 7, lines 63-65; col. 8, lines 55-65, cols. 14-15, lines 59-31); and

whereby said advertising content from said selected advertiser node is displayed at said user node (Cols. 2-3, lines 66-2; col. 8, lines 62-65).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Angeles, et al. teaches that the "invention supports custom advertisements which can contain hyper-links to other information," i.e. these advertisements with their hyperlinks are equivalent to a plurality of advertiser nodes (Col. 4, lines 6-16).

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claim 16, Angeles teaches a network supporting a hypertext transfer protocol comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Abstract; col. 1, lines 45-55; cols. 5-6, lines 62-3; col. 8, lines 38-46; col. 10, lines 43-54);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (col. 2, lines 54-58 and lines 63-66; col. 3, lines 41-65; col. 7, lines 53-60; col. 12, lines 13-35);

an advertisement server node storing information about said user node, said advertisement server node and responsive to a request from said user node based on

said link message to select an advertising banner for said advertising space based upon the information stored about said user node at said advertisement server node and to reply to said request from said user node (col. 7, lines 63-65; col. 8, lines 55-65, cols. 14-15, lines 59-31),

whereby said advertising banner from said advertisement server node is displayed at said user node (Cols. 2-3, lines 66-2; col. 8, lines 62-65).

As per claim 20, Angeles discloses a network in accordance with claim 16:

wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (in the prior art, users can click through an ad banner to obtain additional information about the advertiser – disclosed in Description of the Prior Art; Angeles, col. 4, lines 6-16); and further including

an advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by a user (in the prior art, each advertiser typically maintains a web site including advertising content about their products and services which corresponds to the ad banners displayed on content web sites – disclosed in Description of the Prior Art; Angeles, col. 15, lines 1-31),

whereby said advertising content from said advertiser node is displayable at said user node (once the advertiser's URL address is returned from the ad server to the user's browser, the user's browser would be redirected to the advertiser's web page,

and advertising content from that page would be displayed on the user's computer – Description of the Prior Art; Angeles, cols. 15, lines 1-31).

Claim 23 is rejected for the same reasons set forth in claim 16.

Claim 32 is rejected for the same reasons set forth in claims 16 and 20.

11. Claims 1,3, 7, 9, 13, 16, 20, 23, 25, 32, 35-36, 42, 45 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Reilly, et al. U.S. Patent No. 5,740,549.

As per claim 1, Reilly, et al. teaches a network supporting a hypertext transfer protocol (col. 4, lines 8-10) comprising:

a user node having a browser program coupled to said network (col. 4, lines 2-15), said user node providing request for information on said network (col. 6, lines 26-36; cols. 7-8, lines 45-18);

a content provider node (new story items) having a content provider web site responsive to requests for information from said user node to provide media content (new stories) and advertising space for display of direct advertising content (col. 4, lines 23-34);

an advertiser node (advertisements) responsive to a request to provide said advertising content, said advertiser node responsive to a request to provide said advertising content (cols. 4-5, lines 66-7 and col. 5,lines 26-34); and

an advertisement server node storing information about said user node (advertising display statistics and display scripts), said advertisement server node being responsive to a request from said user node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about

said user node at said advertisement server node and identify said advertiser node as said selected advertiser node as said selected advertiser node to said user node (cols. 5-6, lines 61-34); and

whereby said advertising content from said selected advertiser node is displayable at said user node (Fig. 6; cols. 9-10, lines 65-20).

As per claim 3, Reilly, et al. teaches a network where the advertisement server node selects said advertisement node based on the characteristics of a user (Abstract).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Reilly, et al. teaches that the invention supports advertisements which can contain hyper-links to the advertisers web sites, i.e. these advertisements with their hyperlinks are equivalent to a plurality of advertiser nodes (cols. 14-15, lines 61-11).

Claim 9 is rejected for the same reasons as claim set forth in claim 3.

Claim 13 is rejected for the same reasons as set forth in claims 1 and 7.

As per claim 16, Reilly, et al. teaches a network supporting a hypertext transfer protocol (col. 4, lines 8-10) comprising:

a user node having a browser program coupled to said network (col. 4, lines 2-15), said user node providing request for information on said network (col. 6, lines 26-36; cols. 7-8, lines 45-18);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (col. 4, lines 23-34);

an advertisement server node storing information about said user node, said advertisement server node and responsive to a request from said user node based on said link message to select an advertising banner for said advertising space based upon the information stored about said user node at said advertisement server node and to reply to said request from said user node (Fig. 6; cols. 5-6, lines 61-34),

whereby said advertising banner from said advertisement server node is displayable at said user node (Fig. 6, cols. 9-10, lines 65-20).

Claim 18 is rejected for the same reasons set for in claim 3.

As per claim 20, Reilly, et al. discloses a network in accordance with claim 16:

wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner (cols. 14-15, lines 61-11); and further including

whereby said advertising content from said advertiser node is displayable at said user node (once the advertiser's URL address is returned to the user's browser, the user's browser would be redirected to the advertiser's web page, and advertising content from that page would be displayed on the user's computer cols. 14-15, lines 61-11).

Claim 23 is rejected for the same reasons set forth in claim 16.

Claim 25 is rejected for the same reasons set forth in claim 3.

Claim 32 is rejected for the same reasons set forth in claims 16 and 20.

Claim 35 is rejected for the same reasons set forth in claim 3

Method claim 42 is rejected for the same reasons set forth in claim 16.

Method claim 36 is rejected for the same reasons set forth in claim 36.

Method claim 45 is rejected for the same reasons set forth in claim 20

Method claim 47 is rejected for the same reasons set forth in claim 3.

12. Claims 1-57 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. More than one year prior to the filing date of U.S. Patent 5,948,061, Kevin O'Connor initiated a telephone conversation with Christopher Buckingham. Christopher Buckingham (see Buckingham Deposition, pp. 28-29, lines 14-25). Attachmate employed Christopher Buckingham at that time. Mr. O'Connor discussed the ability of the internet to target ads to people who were surfing the net and that he could target ads based on interpreting the demographics of the people surfing the net, i.e. through the TCP/IP address. (Id. at 32, lines 19-21; at 33, lines 3-12; at 71, lines 14-16). Mr. O'Connor further disclosed a range of products and services related to advertising on the internet that he could provide and that his software could utilize banner ads and target people/customers, job types, or accounts that Buckingham specified in exchange for $20,000. (Id. at 35, lines 2-16; at 36, lines 9-25; at 39, lines 5-11; 72, lines 5-14). It was during that telephone conversation that Christopher Buckingham on behalf of Attachmate agreed to become one of Mr. O'Connor's initial advertising sponsors for targeted advertising. (Id. at 37-38, lines 23-11 and at 64-65, lines 17-14) Mr. O'Connor further indicated that he would provide feedback/reports on the advertising. (Id. at 34, 2-8).

13. Claims 1-57 are rejected under 35 U.S.C. 102(b) as being anticipated by FocaLink's public use of centralized ad serving technology.

FocaLink conceived of and reduced to practice centralized ad serving technology well prior to the filing of the '061 patent as indicated by (1) Mr. Carlick's discussions with Mr. Zinman and FocaLink in 1995, (2) several February 1996 articles in DoubleClick's possession discussing FocaLink as growing out of a project conceived by Messrs. Zinman and Strober while at Stanford Business School the previous Spring, 1995; (3) FocaLink promotional materials also in DoubleClick's possession discussing the detail and origin of FocaLink's Technology, including FocaLink's technology and services during 1995 and 1996 as its competitor in the ad serving market place. See First Amended Answer and Counterclaim of Defendant L90, Inc., pg. 22. This centralized ad serving technology which would select, deliver and monitor targeted advertising was conceived of in the Spring of 1995by the founders of FocaLink and by June 1995, FocaLink, then called Link Marketing, began raising capital for the formation of their ad serving business. Amended Answer and Counterclaims of Sabela Media, Inc., pg. 15. By August 1995 FocaLink began serving advertising banners on a web site named Web Personals through their ad server which would select the ad banner and send it back to the user's browser where it was combined with other textual or graphical information to compose a web page. Id. The user could then click through the banner and be redirected to the advertiser's own web site. Id. Beginning in October 1995 FocaLink began served advertising banners using its SmartBanner ad serving technology for several

companies, including Saturn Cars. Id. During this time period, FocaLink was using a variety of information in order to provide different advertising banners to different users using a variety of information in order to provide different advertising banners to different users viewing the same advertising space on the same web page, i.e., FocaLink was serving targeted advertising. Id.

Thus, Claims 1-57 are rejected in view of LinkMarket's Business Brochure (faxed 7/5/95 – Tab 56); FocaLink's Business Brochure (dated 9/8/95 – Tab 57); Link Market Business Plan (dated June 6, 1995 – Tab 89); FocaLink Press Release – Hyperlink Advertising Explodes on the World Wide Web (July 17, 1995 – Tab 90); FocaLink Media Services, Inc. (dated August 2, 1995 - Tab 215); Depositions of Ron Kovas and David Zinman. These references teach all the elements of claims 1-57 as admitted by applicant in their business plan where they admitted that their ad serving technology was "not patentable" and later discussed FocaLink. Amended Answer and Counterclaims of Sabela Media, Inc. pg. 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 51-52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khoda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on

the browser" (Applicant's submission). Kohda, et al. teaches as discussed above in the 102(a) rejection.

Kohda teaches a network comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network (Fig. 2; pg. 1495, col. 1, fourth paragraph);

a content provider affiliate node having a respective affiliate web site (Fig. 2 – Ordinary Web server and web page) responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node (Fig. 2);

an advertiser node having an advertiser web site including advertising content (Fig.2; pg. 1494, col. 2, first full paragraph), said advertiser node responsive to a request to provide advertising content (Fig.2; pg. 1494, col. 2, first full paragraph); and an advertisement server node responsive to a request from said user node based on said link message to select said advertiser node as a selected advertiser node, and identify said advertiser node as said selected advertiser node to said user node (Fig. 2 Advertiser's Web server and an advertisement web page; pg. 1495, cols. 1-2, Sections 2.2 and 2.3, and pp. 1497-98, Section 3.2),

whereby said advertising content from said advertiser node is displayable at said user node (pg. 1495, col. 1, Section 2.2),

However, Kohda, et al. does not specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously

displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

Claim 51 is rejected for the same reasons set forth in claim 2 as set forth above.

Claim 52 is rejected for the same reasons set forth in claims 8 and 51.

15. Claims 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. as applied to claims 16-17, 20, 23-24, 32-33, 38 and 46 above, and further in view of Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997.

As per claim 53, Kohda, et al. discloses as discussed above in the 102(a) rejection. Kohda, et al. does not disclose the specific display type/form/positioning of advertising, i.e. banner or interstitial, that would be selected. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of the advertiser, and that in many instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); *see also* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997 (Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the

problem with lack of targeting the consumer). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select and display an advertising banner in order to increase the efficacy of contact with users. Moreover, Kohda, et al. does not specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser. Thus, increasing the efficiency and profitability of advertiser.

Claims 54-57 are rejected for the same reasons set forth in claims 24, 33, 38 and 46 respectively in the previous office action.

16. Claim 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler, U.S. Patent No. 5,960,409 or Angeles, et al., U.S. Patent No. 5,933,811. Wexler and Angles teach a network comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network (Wexler – col. 2, lines 43-46; Angeles – Abstract, col. 1, lines 45-55, cols. 5-6, lines 62-3, col. 8, lines 38-46, col. 10, lines 43-54);

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising

space for display of advertising content and a link message to said user node (Wexler – col. 3, lines 36-44 and col. 4, lines 28-36; Angeles – col. 2, lines 54-58 and lines 63-66, col. 3, lines 41-65, col. 7, lines 53-60, col. 12, lines 13-35);

an advertiser node having an advertiser web site including advertising content, said advertiser node responsive to a request to provide advertising content (Wexler - col. 5, lines 1-23; Angeles - col. 4, lines 6-16); and an advertisement server node responsive to a request from said user node based on said link message to select said advertiser node as a selected advertiser node, and identify said advertiser node as said selected advertiser node to said user node (Wexler – col. 4, lines 37-67; Angeles – col. 7, lines 63-65, col. 8, lines 55-65, col. 14-15, lines 59-31),

whereby said advertising content from said advertiser node is displayable at said user node (Wexler – col. 4, lines 4-7; Angeles – cols. 2-3, lines 66-2, col. 8, lines 62-65).

However, neither Wexler, nor Angeles, et al. specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Moreover, this limitation is known in the prior art as "burnout," and reflects the well-known notion that continuous exposure to the same advertisement generally reduces the response rate to the advertisement. (Description of the Prior Art, col. 1, lines 54-59). Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate

contracted with the advertiser. Thus increasing the efficiency and profitability of the advertiser.

Claim 51 is rejected for the same reasons set forth in claim 2 as set forth above.

Claim 52 is rejected for the same reasons set forth in claims 8 and 51.

Claims 53-57 are rejected for the same reasons set forth in claims 17, 24, 33, 38 and 46.

Remarks

Applicant's arguments regarding Minor, et al. filed July 24, 2001 have been fully considered and are deemed persuasive. thus, the rejections under Minor, et al. are withdrawn in light of applicant's arguments.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shaw, et al. U.S. Patent No. 5,809,242 which discloses an electronic mail system for displaying advertisement at local computer received from a remote while the local computer is off-line with the remote system. Shaw, et al. discloses targeting the advertising utilizing a variety of techniques including user profiles and statistical information on viewing, such as number of times viewed types of advertisements clicked through etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.5357 for regular communications and 703.308.5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

jih
October 22, 2001

Richard Chilcot
Supervisory Patent Examiner
Technology Center 2167